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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/621,973 | 07/17/2003 | Don Millerd | 11371.9 | 2586 |
| 23862 | 7590 | 07/28/2005 | EXAMINER | |
| NYDEGGER & ASSOCIATES 348 OLIVE STREET SAN DIEGO, CA 92103 | | | MAIORINO, ROZ | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3763 | |
| DATE MAILED: 07/28/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,973

Applicant(s)

MILLERD, DON

Examiner

Roz Maiorino

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3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-20 is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: It is the Examiner's position that Applicant has evoked sixth paragraph, means-plus-function language to define Applicant's invention. Therefore the Examiner requires the Applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o) to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, and acts perform the function recited in the claim element. Please note that the MPEP clearly states, "Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to the means-(or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the PTO may still require the applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o)...". (Also see **MPEP 2181** (Rev. 1, Feb.2000))

Appropriate correction is required.

Claim Objections

2. Claims 1-8 are objected to because of the following informalities: It is the Examiner's position that Applicant has evoked sixth paragraph, means-plus-function language to define Applicant's invention. Therefore the Examiner has objected to the claims for the reasons set forth above in the objection to the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent NO. 6869415 to Asbaghi.

Asbaghi teaches a system for protecting a needle which comprises: a holder supporting the needle, the holder being formed with a first abutment and a second abutment; a guard moveable on the holder over the needle and having a surface

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formed with a cantilevered tab and an extension limiter, wherein the cantilevered tab is moveable between a stressed configuration with the cantilevered tab positioned for contact against the first abutment to prevent movement of the guard on the holder in a first direction, and an unstressed configuration wherein the cantilevered tab is flush with the surface of the guard to avoid contact with the first abutment; and a means for urging the cantilevered tab against the first abutment to maintain the cantilevered tab in its stressed configuration until the guard is moved in a second direction, the second direction being substantially opposite the first direction, to release the cantilevered tab from the first abutment for transition from its stressed configuration to its unstressed configuration, and for subsequently urging the guard in the first direction to cover the needle and place the extension limiter in contact with the second abutment to protect the needle by preventing movement of the guard back in the second direction. (figs 1-3b)

4. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent NO. 6203529 to Gabriel et al.

Gabriel teaches a system for protecting a needle which comprises: a holder supporting the needle, the holder being formed with a first abutment and a second abutment; a guard moveable on the holder over the needle and having a surface formed with a cantilevered tab and an extension limiter, wherein the cantilevered tab is moveable between a stressed configuration with the cantilevered tab positioned for contact against the first abutment to prevent movement of the guard on the holder in a first direction, and an unstressed configuration wherein the cantilevered tab is flush

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with the surface of the guard to avoid contact with the first abutment; and a means for urging the cantilevered tab against the first abutment to maintain the cantilevered tab in its stressed configuration until the guard is moved in a second direction, the second direction being substantially opposite the first direction, to release the cantilevered tab from the first abutment for transition from its stressed configuration to its unstressed configuration, and for subsequently urging the guard in the first direction to cover the needle and place the extension limiter in contact with the second abutment to protect the needle by preventing movement of the guard back in the second direction. (figs 1-10)

5. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent NO. 6641555 to Botich et al.

Botich teaches a system for protecting a needle which comprises: a holder supporting the needle, the holder being formed with a first abutment and a second abutment; a guard moveable on the holder over the needle and having a surface formed with a cantilevered tab and an extension limiter, wherein the cantilevered tab is moveable between a stressed configuration with the cantilevered tab positioned for contact against the first abutment to prevent movement of the guard on the holder in a first direction, and an unstressed configuration wherein the cantilevered tab is flush with the surface of the guard to avoid contact with the first abutment; and a means for urging the cantilevered tab against the first abutment to maintain the cantilevered tab in its stressed configuration until the guard is moved in a second direction, the second direction being substantially opposite the first direction, to release the cantilevered tab

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from the first abutment for transition from its stressed configuration to its unstressed configuration, and for subsequently urging the guard in the first direction to cover the needle and place the extension limiter in contact with the second abutment to protect the needle by preventing movement of the guard back in the second direction. (figs 1-32)

Allowable Subject Matter

Claims 10-20 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roz Maiorino whose telephone number is 571- 272-4960. The examiner can normally be reached on 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4377. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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RM

A handwritten signature, possibly reading 'RM', in black ink.A handwritten signature in black ink, appearing to be 'Nicholas D. Lucchesi'.

**NICHOLAS D. LUCCHESI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700**